Supreme Court, U.S.
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No. _____

In The

Supreme Court of the United States

October Term, 1998

STUN-TECH, INC.,

Petitioner,

vs.

R.A.C.C. INDUSTRIES, INC.,

Respondent.

On Petition For Writ Of Certiorari To The United States Court Of Appeals For The Federal Circuit

PETITION FOR WRIT OF CERTIORARI

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QUESTION PRESENTED FOR REVIEW

Does the inclusion of functional language in an apparatus claim, in a manner not provided for by 35 U.S.C. § 112, ¶ 6 transform the claim into a method-hybrid claim?

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PETITION FOR WRIT OF CERTIORARI

Stun-Tech, Inc., Petitioner herein, respectfully prays that a writ of certiorari issue to review the judgment of the United States Court of Appeals for the Federal Circuit entered December 2, 1998 affirming the judgment of the United States District Court for the District of Maryland.

OPINION BELOW

The opinion of the District Court is reprinted in the appendix to this petition. The opinion of the Court of Appeals is also reprinted in the appendix to this petition.

JURISDICTION

The judgment of the United States Court of Appeals for the Federal Circuit was entered on December 2, 1998. The jurisdiction of this Court is invoked under 28 U.S.C. § 1254(1).

STATUTES INVOLVED

35 U.S.C. Sec. 101

Inventions Patentable

Whoever invents or discovers any new and useful process, machine, manufacture or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

35 U.S.C. Sect. 112, ¶ 6

Specification

An element in a claim for a combination may be expressed as a means or step for performing a specific function without the recital of structure, material or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

STATEMENT OF THE CASE

The subject of this litigation is a remotely activated stun belt for use in prisoner control.

Stun belts are part of a category of prisoner control apparatus in which an electrical shock may be applied to the body of a prisoner to momentarily incapacitate the prisoner. A stun device may take several different forms.

One form of stun device is a stun gun that is hand held by a police officer. The stun gun is roughly the size of a television "clicker" or remote control and has two electrodes at the end thereof. When the gun is thrust into the body of a prisoner and activated by depressing a button, an electrical shock is imparted to the prisoner causing momentary incapacitation. The shock is developed from a 9-volt battery.

Another form of stun device is the incorporation of a stun gun in a police shield. Thrusting of the shield against the body of a person (as in a riot situation) and subsequent activation of the stun element causes an electrical shock to be imparted to that person.

A still further form of stun device is the remote activated stun device. By mounting a stun package to the body of a prisoner using a belt, a radio control may be used to remotely activate the stun device. Should, for example, the prisoner attempt to flee, the officer need merely press a button on his or her transmitter and the stun device, which is secured to the prisoner's body, will be activated causing temporary incapacitation of the prisoner. The remote control device, thus, operates much on the same principle as a garage door opener.

Patent 4,943,885 is directed to a miniaturized remotely activated stun device that makes it possible for the stun element to be belted to a prisoner's body *under clothing in a nonobvious manner* thereby promoting courtroom use of the control apparatus.

In some jurisdictions, it is considered desirable to permit an accused to appear in court with a hidden restraint stun device under the prisoner's clothing. Under these circumstances, the prisoner's presumption of innocence is not denigrated by a public display of handcuffs, manacles, leg irons or the like. The miniaturized stun apparatus makes it possible for the accused to appear in street clothing and, for all intents and purposes, without any evidence of a restraint system in use. Should the accused seek to escape custody while in the courtroom, or while being transported to or from the courtroom, the control officer need merely activate his or her radio transmitter to cause the stun device to activate, thus, incapacitating the accused.

Figure 2 of Patent '885 (App. 20) illustrates the placement of the stun unit on the body of a prisoner as described in the patent.

As shown in Figure 2 of Patent '885, a radio receiving unit 31 belted to the body of a prisoner by means of belt 52. A stun or shock unit 36 is also belted to the body of the prisoner. The police officer or corrections official carries a transmitter unit. When the receiving unit 31 is activated by a signal from the transmitter unit, it sends a command to the shock unit 36. A jolt of electricity is then discharged from the stun unit by electrodes that are urged directly against the prisoner's skin or against light clothing (i.e., an undershirt).

The receiving unit 31 and stun or shock unit 36 are relatively small as shown in Figure 2 having a size approximating the size of a pack of cigarettes.

Claims 1 and 4 were accused to be infringed by the plaintiffs. Claims 1 and 4 are independent claims and read as follows:

> 1. Apparatus for control of a dangerous prisoner to prevent unpredictable dangerous actions by said dangerous prisoner while in social context situations while nevertheless concealing such apparatus from public view, comprising: incapacitant delivery means, torso mounting means comprising a belt of sufficient extent to encircle a prisoner's torso and means for securing said incapacitant delivery means in contact with said prisoner's torso, said mounting means being adapted for concealment beneath garments ordinarily worn by ordinary persons in said social context to prevent said prisoner from being marked by observers in said social context

as a person under restraint, said incapacitant delivery means being powered to deliver an incapacitating electrical shock to said prisoner, said mounting means further including means for receiving a remotely activated signal, and means in said mounting means responsive to said signal for delivering said incapacitating electrical shock to said prisoner.

4. Nonobvious prisoner control apparatus for operation by a controlling authority located remotely from a prisoner, while said prisoner is in clothing both appropriate to a public situation, and permitting normal functions of movement by said prisoner comprising: means concealable beneath said appropriate clothing of said prisoner to, be controlled, securely banded around said prisoner's torso, for delivery of a nonlethal disabling electrical impulse to said prisoner, means connected to said electrical impulse delivery means for receiving a signal, including means for activating said electrical impulse delivery means upon receipt of said signal, and means, operable by said controlling authority, for generating and transmitting said signal for activating said electrical impulse delivery means to disable said prisoner.

Two models of defendant's stun belts were accused of infringement. The District Court found that the defendant's MSB (Minimum Security Belt) and HSTB (High Security Transport Belt) infringed claims 1-4 of patent '885. The finding of the District Court was affirmed by the Federal Circuit.

The HSTB belt of the defendants is a comprehensive belt used primarily for the transport of prisoners. The belt includes a stun unit pouch, forearm restraints and an

attachment "D" ring for handcuffs and leg irons. These elements are illustrated at A 21.

The HSTB belt of the defendant is adapted to be worn over clothing and is sold specifically for that purpose. It is a highly visible prisoner restrain system that includes not only a stun package but also forearm restraints and handcuff and leg iron attachments.

REASONS FOR GRANTING THE WRIT

The claims at issue are apparatus claims with functional limitations as to the manner of use of the apparatus being claimed. These functional limitations, however, are not claimed as "means plus function" elements as is provided for in 35 U.S.C. § 112, ¶ 6. Rather, the functional limitations describe the use of the apparatus *as a whole*.

The functional language in claim 1 reads as follows:

> "Apparatus for control of a dangerous prisoner to prevent unpredictable dangerous actions by said dangerous prisoner while in social context situations while nevertheless concealing such apparatus from public view" and
>
> "mounting means being adapted for concealment between garments ordinary worn by ordinary persons in said social context."

Claim 4 also includes functional language as follows:

> "Nonobvious prisoner control apparatus for operation by a controlling authority located remotely from a prisoner, while said prisoner is

> in clothing both appropriate to a public situation, and permitting normal functions of movement by said prisoner"; and "means concealable beneath said appropriate clothing of said prisoner."

This Court has noted that 35 U.S.C. § 112, ¶ 6 permits an applicant to describe an element of his invention by the result accomplished or the function served, rather than describing the item or element to be used (e.g., "a means of connecting part A to part B" rather than "a two-penny nail"). *Warner-Jenkinson Company, Inc. v. Hilton Davis Chemical Co.*, 117 S.Ct. 1040 (1997).

The reference to the "means" claiming provision of the 1952 act is the only reference in Title 35 to the use of functional language in an apparatus claim.

It is commonplace in patent practice today to liberally sprinkle functional language in apparatus claims to define patentable subject matter over the prior art. In some cases when this is done, the Patent Office examiner may require that the claim be converted to a method claim. In other cases, the examiner may require that the claim language be altered so that the functional language appears as a part of a "means plus function recitation" which is provided for in Section 112, ¶ 6. Yet in spite of this practice, a significant number of claims are issued each year in which there is pure functional language in an apparatus claim which has no relation to Section 112, ¶ 6 and which was the reason for the claim being allowed in the first instance.

In the case at hand, the use of radio controlled stun elements for attachment to the body of a prisoner was in the prior art.

The '885 patent was granted when the functional language described above was added to the claims and it was urged that the patented device could be worn under clothing where it would be effectively concealed. As a result, the unit, it was urged, could be worn in a courtroom setting. The prior art Lai device, it was urged, could not be concealed.

The District Court found that the accused HSTB belt was used primarily for the transport of prisoners in a manner that the stun unit was clearly visible to the general public. The District Court also found, however, that because the accused HSTB belt was "capable of concealment," as when it would be worn under clothing, it constituted an infringement of Patent '885.

The impact on the defendant is significant. It means that all units manufactured by the defendant are considered infringing units even if they are not used in the manner contemplated by the patent. Defendant's exposure was not limited, by the District Court, or the Federal Circuit, to devices that were actually used in the courtroom in a concealed manner.

This Court, in *Warner Jenkinson Co., supra*, has laid out the steps of an infringement determination under Section 112, ¶ 6. It is submitted that the Court should now lay out the steps to be followed in analyzing patent infringement where there is functional language in an

apparatus claim that describes the manner of use of the apparatus.

THE WRIT SHOULD BE GRANTED

To decide important questions of federal law which have not been but should be settled by this Court.

Respectfully submitted,

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United States Court of Appeals for the Federal Circuit

98-1186

R.A.C.C. INDUSTRIES, INC.,

Plaintiff/Counterclaim
Defendant-Appellee,

and

CARL W. ROY II and BRIAN D. WILLOUGHBY,

Counterclaim Defendants-Appellees,

v.

STUN-TECH, INC.,

Defendant/Counterclaimant-Appellant,

and

DENNIS KAUFMAN,

Defendant-Appellant.

and

LEO R. WARD,

Defendant.

DECIDED: December 2, 1998

Before RICH, RADER, and SCHALL, *Circuit Judges.*

RADER, *Circuit Judge.*

The United States District Court for the District of Maryland granted summary judgment of infringement of a patent on remotely activated stun belts for restraining prisoners. R.A.C.C. Industries, Inc. (RACC) initiated this action against Stun-Tech, Inc. and its president, Dennis

Kaufman, (collectively Stun-Tech) alleging infringement of its U.S. Patent No. 4,943,885 (the '885 patent).

After preliminary hearings and construction of the claims by the district court, both parties moved for summary judgment. The district court granted summary judgment in favor of RACC. The district court enjoined Stun-Tech from making, using, selling or otherwise distributing its Minimum Security Belt (MSB) and High Security Transport Belt (HSTB), both sold under the name "R-E-A-C-T Belt System," during the remainder of the life of the '885 patent. Stun-Tech appeals the district court's claim construction and the finding of infringement of the '885 patent. Because the district court did not err in its construction of the claims of the '885 patent nor in its entry of summary judgment, this court *affirms*.

i.

The '885 patent discloses a remotely activated, non-obvious (i.e., concealable) prisoner control apparatus. The prisoner control apparatus of the '885 patent is a torso-mounted stun belt which delivers an incapacitating electric shock to a disruptive prisoner wearing the belt when activated. The stun belt includes a radio receiver and a stun unit. The stun unit has several electrodes which are placed against the prisoner's body to deliver the electric shock. A radio transmitter remotely activates the stun belt to incapacitate the disruptive prisoner. To accommodate constitutional due process concerns and facilitate fair trials for dangerous prisoners, the stun belt of the '885 patent is capable of being concealed under ordinary

clothing. This feature allows use of the belt in a courtroom or other public setting without identifying the prisoner as being under restraint.

On or about October 1, 1990, Stun-Tech entered into an exclusive license agreement with RACC. The license agreement gave Stun-Tech the exclusive right to manufacture and sell the stun belt embodied in the '885 patent in exchange for royalty payments. Stun-Tech later ceased royalty payments contrary to this agreement after it redesigned its stun belts in an attempt to evade the '885 patent claims. In this attempt, Stun-Tech placed the radio receiver and stun package in a single pouch which produces a noticeable bulge when worn under a prisoner's clothing. With this change, Stun-Tech hoped to evade the portions of the patent claims concerning concealability. RACC terminated the license agreement on December 28, 1992 and subsequently instituted this action against Stun-Tech for infringement of the '885 patent.

The '885 patent claims at issue include independent claims one and four. Claim one recites:

> 1. Apparatus for control of a dangerous prisoner to prevent unpredictable dangerous actions by said dangerous prisoner while in social context situations *while nevertheless concealing such apparatus from public view,* comprising:
>
> incapacitant delivery means,
>
> torso mounting means comprising a belt of sufficient extent to encircle a prisoner's torso and means for securing said incapacitant delivery means in contact with said prisoner's torso,

said mounting means *being adapted for concealment beneath garments ordinarily worn by ordinary persons* in said social context *to prevent said prisoner from being marked by observers in said social context as a person under restraint,*

said incapacitant delivery means being powered to deliver an incapacitating electrical shock to said prisoner,

said mounting means further including means for receiving a remotely activated signal, and

means in said mounting means responsive to said signal for delivering said incapacitating electrical shock to said prisoner.

(emphasis added). Claim four provides:

4. *Nonobvious prisoner control apparatus* for operation by a controlling authority located remotely from a prisoner, while said prisoner is in clothing both appropriate to a public situation, and permitting normal functions of movement by said prisoner comprising:

means concealable beneath said appropriate clothing of said prisoner to[] be controlled, securely banded around said prisoner[']s torso, for delivery of a nonlethal disabling electrical impulse to said prisoner,

means connected to said electrical impulse delivery means for receiving a signal, including means for activating said electrical impulse delivery means upon receipt of said signal, and

means, operable by said controlling authority, for generating and transmitting said signal

> for activating said electrical impulse delivery means to disable said prisoner.

(emphasis added).

Stun-Tech presented two primary arguments as to why its stun belts did not infringe these claims, both focusing on the concealability limitations. First, Stun-Tech argued that combination of the radio receiver and stun package in a single pouch produce a noticeable bulge when worn under clothing. Therefore, Stun-Tech urged, they are not "adapted for concealment" or "concealable" as required by the '885 patent claims. Second, Stun-Tech argued that the claim language about concealability created a hybrid apparatus and method of use claim which requires concealment in actual use. Stun-Tech asserted that its belts are primarily used in open prisoner transport situations often in combination with handcuffs and shackles – far from a concealment situation. Because of this allegedly non-infringing use, Stun-Tech sought to avoid direct infringement.

The district court did not agree with either of Stun-Tech's contentions. The district court rejected Stun-Tech's proposed "hybrid" claim interpretation, instead construing both claims solely as apparatus claims. According to the district court, Stun-Tech provided "absolutely no citation to authority [for its argument] that the R-E-A-C-T belts cannot infringe on the '885 patent because they are designed to be worn outside of the clothing." The district court added that "Stun-Tech's own characterization of how its product ought to be used cannot change the fact that the product otherwise infringes every element of the claims."

The district court then construed the concealability limitations to require only that the stun belts "when worn under clothing ordinarily worn by a defendant in social situations, [not] be noticeable, observable, or discern[ible] *as a prisoner control apparatus.*" The district court stated that "the apparatus must be concealable 'beneath garments ordinarily worn by ordinary persons in said social context *to prevent said prisoner from being marked by observers in said social context as a person under restraint.*' " The district court continued: "This objective can be achieved by concealing the nature of the device while it is not necessary to conceal the very existence of the device." Based on this claim interpretation, the district court found that even though the accused devices produced a noticeable bulge under a prisoner's clothing, this did not avoid infringement of the '885 patent. The district court therefore granted RACC's motion for summary judgment. Stun-Tech appeals both the district court's claim interpretation and its grant of summary judgment of infringement.

II.

This court reviews issues of claim construction *de novo*. *See Cybor Corp. v. FASTech, Inc.*, 136 F.3d 1448, 1454, 46 USPQ2d 1169, 1172 (Fed. Cir. 1998) (in banc). With respect to the district court's grant of summary judgment, this court reviews for itself the requirements for summary judgment. *See Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 247 (1986). In making that review, this court enforces the requirement that a trial court may not enter summary judgment in a case with material facts in dispute. *See* Fed.

R. Civ. P. 56(c). Further, in a summary judgment proceeding, the trial court initially, and this court on review, construes all factual inferences and resolves all doubts in favor of the non-moving party. *See Anderson*, 477 U.S. at 255; *Chiuminatta Concrete Concepts, Inc. v. Cardinal Indus., Inc.*, 145 F.3d 1303, 1307, 46 USPQ2d 1752, 1755 (Fed. Cir. 1998).

On appeal, Stun-Tech asserts that the district court erred in its claim interpretation. Stun-Tech argues that claims one and four should be construed as hybrid apparatus and method of use claims. Stun-Tech further contends that these claims, when properly construed, cannot be infringed unless the accused device is used according to method of use limitations in the claims. Stun-Tech cites *in re Benson*, 418 F.2d 1251, 164 USPQ 22 (CCPA 1969), *In re Swinehart*, 439 F.2d 210, 169 USPQ 226 (CCPA 1971), and *ZMI Corp. v. Cardiac Resuscitator Corp.*, 844 F.2d 1576, 6 USPQ2d 1557 (Fed. Cir. 1988) in support of its unique hybrid claim argument. These cases, however, do not authorize this court to transform an apparatus claim into a hybrid apparatus and method of use claim. Rather, these cases merely acknowledge that an apparatus claim may include functional limitations. Similarly, in *Intel Corp. v. U.S. International Trade Commission*, 946 F.2d 821, 832, 20 USPQ2d 1161, 1171 (Fed. Cir. 1991), this court interpreted functional language in an apparatus claim as requiring that an accused apparatus possess the capability of performing the recited function. This court has never determined that functional language in a claim converts an apparatus claim into a method of use or hybrid claim.

Although claims one and four of the '885 patent contain recitations about concealability, the prosecution history demonstrates that this language does not make these claims method of use claims. Specifically, the prosecution history shows that the Examiner initially rejected all of the application's claims based on U.S. Patent No. 4,089,195 (Lai), which discloses a stun device in handcuffs. In response, RACC attempted to establish patentability of its claims over Lai based solely on intended use:

> By contrast the applicants' device can be worn comfortably by the prisoner without restriction of the prisoner's freedom of movement and without the need for the prisoner's restraint becoming noticeable to even the closest observer.

The Examiner rejected RACC's argument, however, and again rejected the claims based on Lai, noting that the concealability of the apparatus did not change the fact that the claims did not recite any structure different from Lai. Accordingly, RACC then amended its claims to recite structural differences from Lai, namely, a belt of sufficient length to fasten around the torso. With the addition of this structural limitation, the Examiner allowed the claims.

This prosecution history shows that RACC was unable to distinguish its invention from the prior art based solely on intended use. Only by adding the structural limitation requiring torso mounting did RACC successfully overcome the prior art. Accordingly, the district court correctly decided that the functional language in

claims one and four does not convert them into method of use or hybrid claims.

The claims do, however, recite concealability as a necessary limitation. Claim 1 recites a mounting means "adapted for concealment" while claim 4 recites a "means concealable beneath said appropriate clothing." This functional language limits the scope of these claims to devices that have the *capability* of being concealed. *See Intel Corp.*, 946 F.2d at 832 (Regarding patent claims to an EPROM, "the accused device, to be infringing, need only be capable of operating in the page mode. . . . [A]ctual page mode operation in the accused device is not required."). The district court therefore also correctly construed claims one and four as requiring the capability of being concealed although not requiring concealment in actual use.

Furthermore, the district court correctly construed the apparatus claims to cover an apparatus not "noticeable, observable, or discernible *as a prisoner control apparatus.*" The specification, the prosecution history, and, most importantly, the claims themselves support this reading. The language of claim one is particularly telling. Claim one recites "mounting means . . . adapted for concealment . . . *to prevent said prisoner from being marked* by observers in said social context *as a person under restraint.*" '885 patent, col. 9, ll. 1-5 (emphasis added). Thus, this language emphasizes a mounting means adapted for concealment in a courtroom setting. The specification of the '885 patent further clarifies that this language provides "means for control of dangerous prisoners in public trial . . . *without the stigma of visible restraints* so as to enable the restrained accused to appear

as a normal, ordinary member of society." *Id.* at col. 3, ll. 15-19. Furthermore, during prosecution of the '885 patent, RACC stated that its belt would allow a prisoner's freedom of movement, "*without* the need for *the prisoner's restraint becoming noticeable* to even the closest observer." (emphasis added). These defining statements support the district court's conclusion that the concealment limitations specify an apparatus not "noticeable, observable, or discernible *as a prisoner control apparatus.*" The district court correctly determined that these claims require only that an ordinary observer would not identify the apparatus as a prisoner control device when worn under ordinary clothing. The district court therefore appropriately concluded that the noticeable bulge under the clothing when the accused device is secured to a prisoner's torso does not remove the accused device from the proper scope of the claims.

Stun-Tech challenged the district court's grant of summary judgment of infringement solely on the district court's alleged error in claim construction. Stun-Tech did not show that a genuine issue of material fact precludes summary judgment. Because this court agrees with the district court's claim construction, and because this court further agrees with the district court that no genuine issue of material fact bars the grant of summary judgment of infringement, the decision of the district court is affirmed.

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF MARYLAND

R.A.C.C. INDUSTRIES, INC.,	:	Civil Action No.
	:	DKC 93-1802
v.	:	
STUN-TECH, INC., et al.	:	

ORDER GRANTING INJUNCTIVE RELIEF

The court has found that the R-E-A-C-T Belts manufactured and distributed by Stun-Tech, Inc., infringe Patent No. 4,943,885, issued July 24, 1990, owned by Carl W. Roy, II and Brian D. Willoughby and assigned to R.A.C.C. Industries, Inc., rejecting Stun-Tech's legal and factual arguments that the belts do not infringe the elements referred to as "concealing means" and "securing means." Accordingly, it is this 15th day of January, 1998, by the United States District Court for the district of Maryland, ORDERED that:

1. Stun-Tech, Inc., its officers, agents, servants, employees, and attorneys, and any persons in active concert or participation with them who receive actual notice of this order, are enjoined from making, using, selling or otherwise distributing the Minimal Security Belt (MSB) and the High Security Transport Belt (HSTB), both sold under the name "R-E-A-C-T Belt System," during the remainder of the life of the '885 patent; and

2. The Clerk will mail copies of the Memorandum Opinion and this Order to counsel for the parties.

/s/ Deborah K. Chasanow
DEBORAH K. CHASANOW
United States District Judge

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF MARYLAND

R.A.C.C. INDUSTRIES, INC.,	:	
v.	:	Civil Action No. DKC 93-1802
STUN-TECH, INC., et al.	:	

MEMORANDUM OPINION CONCERNING INJUNCTIVE RELIEF

At a hearing held August 21, 1997, the court heard testimony and received exhibits concerning the appropriate scope of injunctive relief based on the court's earlier finding of patent infringement. For the reasons that follow and pursuant FED. R. CIV. P. 65,[1] Stun-Tech, Inc., its officers, agents, servants, employees, and attorneys, and any persons in active concert or participation with them who receive actual notice of this order, are enjoined from making, using, selling or otherwise distributing the Minimum (or Minimal) Security Belt (MSB) and the High Security Transport Belt (HSTB), both sold under the name "R-E-A-C-T Belt System" during the remainder of the life of Patent No. 4,943,885 [hereinafter referred to as the '885 patent].

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[1] Pursuant to FED. R. CIV. P. 65, an order granting an injunction shall set forth the reasons for its issuance, be specific in terms, describe in reasonable detail and not by reference to the complaint or other document the act to be restrained, and be binding only upon the parties to the action, their officers, agents, servants, employees, and attorneys, and those persons in active concert or participation with them who receive actual notice of the order.

I. Legal Standard

Pursuant to 35 U.S.C. § 283, the court "may grant injunctions in accordance with the principles of equity to prevent the violation of any right secured by patent, on such terms as the court deems reasonable." An injunction may prevent infringing use during the term of the patent, but not beyond. *Joy Technologies, Inc. v. Flakt, Inc.*, 6 F.3d 770, 776 (Fed. Cir. 1993).

II. Analysis

Defendant continues to seek reconsideration of the summary judgment decision finding that the R-E-A-C-T Belts infringe the '885 patent by reference to *Warner-Jenkinson Co. v. Hilton Davis Chemical Co.*, 117 S.Ct. 1040 (1997), a "doctrine of equivalents" case discussing "prosecution history estoppel." Because this is a direct, literal infringement case, however, *Hilton Davis* is inapposite.

Next, with regard to injunctive relief, Stun-Tech argues that an order requiring Stun-Tech to provide notice to users to avoid the infringing use would suffice to avoid patent infringement. Stun-Tech cites no cases where such measures have been found to resolve the direct infringement found to exist here. Notice restrictions on products raise issues in contract and antitrust, as well as patent misuse. *See e.g. Kendall Co. v. Progressive Medical Technology, Inc.*, 85 F.3d 1570, 1575 (Fed. Cir. 1996) (citing *Mallinckrodt, Inc. v. Medipart, Inc.*, 976 F.2d 700 (Fed. Cir. 1992)). Violation of a proper notice might make the violator liable for contributory infringement. Notice restrictions, however, cannot be used by Stun-Tech to avoid a finding of direct infringement. Accordingly, the

court concludes that only an injunction prohibiting the sale of the infringing product will issue.

There are two products produced by Stun-Tech, Inc. under the name R-E-A-C-T Belt System: the High Security Transportation Belt or HSTB, and the Minimum [or Minimal] Security Belt or MSB. On the summary judgment record, it was not clear whether both belts infringed the '885 patent, or whether only the MSB was a direct infringement. The purpose of the hearing was to enable the court to view the belts and to hear evidence on whether the HTSB was capable of concealment.

Stun-Tech contends that its belts are marketed primarily for use in prisoner transport and relies on training and policy manuals of its customers to demonstrate that the belts are rarely if ever used without the addition of handcuffs, chains, or shackles. It argues that the addition of the hardware, worn on the outside of clothing, destroys the concealment that is a necessary element of the patent. It concedes, as it must, though, that it does not control the actual use of the product by the customers and estimates that as much as 20% of the time, the belt is used in a courtroom setting, albeit not necessarily in front of a jury.

At the hearing, Dennis R. Kaufman, president of Stun-Tech, testified and demonstrated certain aspects of the belts. The MSB was introduced as Defendant's ex. G.[2] It consists of a five inch wide length of elastic, with a pouch sewn to it, and a narrower two inch wide outer

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[2] Defendant's ex. E consists of photographs of the MSB and the profile sheet for that belt first used in 1993.

belt. The second, narrower belt holds the first belt against the body so contact is not broken. The elastic belt expands and contains several strips of velcro at various intervals for use in sizing the belt. The belt will fit waists of 26 to 52 inches. The pouch is designed to contain electronics, a receiver, and a battery pack.[3] Although handcuffs are not provided with the MSB, they can be looped through the outer belt. Mr. Kaufman explained how the stun package operates when a signal is sent to the receiver worn by the prisoner from the transmitting device held by the correctional officer. The signal can go through a layer, or layers, of clothing perhaps consisting of two shirts or a light weight jacket. The belt will operate with the pouch located anywhere around the torso, but because it will not work very well over bone, Stun-Tech recommends that the pouch be positioned over the kidney area on a person's left side.

The velcro strips are the only means used to secure the outer and inner belts and a person whose hands are not restricted by handcuffs could, in Mr. Kaufman's estimation, open the belts in a few minutes. Despite Mr. Kaufman's opinion, it appears to the court that the many strips of velcro make it difficult and cumbersome to remove the belt. The length of time required for someone to unhook both belts worn underneath clothing would allow correctional personnel ample time to use the stun mechanism or otherwise subdue the prisoner before the belt could be removed.

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[3] The model demonstrated in court did not contain the actual electronics package, but rather a replica.

Stun-Tech's HSTB is Defendant's ex. H.[4] It differs from the MSB because it contains wrist cuffs and metal rings on each side and a metal D ring in the center for a pair of handcuffs. The HSTB is shipped with a pouch that slides onto the side and is secured with velcro. Again, the electronics package goes inside the pouch. Mr. Kaufman estimated that an unrestrained person could remove this belt in seven seconds.

Stun-Tech sells one kit containing both the MSB and the HSTB with one electronics package usable with either belt. The electronics are identical for both belts.

The HSTB is designed to accommodate several levels of security, including placing a prisoner's wrists in handcuffs and the belt cuffs around the forearms. The forearm straps come with the belt, and the rings can accommodate a waist chain and leg shackles. The forearm cuffs can be put around a person's wrists without the addition of a pair of handcuffs.

This belt is called a "transport" belt because it is used primarily to transport people from facility to facility. The HSTB is sold to the Federal Bureau of Prisons, various United States Marshals' offices, state corrections offices, and county sheriffs.

The only on/off key lock is for the electronics and not for securing the belt to a person. An officer must unlock the electronics package on the belt in order to render it active. Otherwise, the belt contains no "locking" mechanism for securing it to the prisoner.

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[4] Again, the photographs and promotional literature in ex. F were first used in 1993.

Stun-Tech contends that, if either belt is used with handcuffs, the handcuffs will be visible even if the belt is under clothing. Shackles or chains also would be clearly visible. It also argues that it recommends, and its customers' usage policies provide, that the belts always be used with such supplemental restraints.

Mr. Kaufman estimated that the transport belt is used 80 to 85% of the time for transport, and the remaining 15 to 20% of the time in a courtroom. The HSTB is designed for high risk people, who pose a particularly high risk when outside a facility. He explained that, when a person goes to trial, the person may not already be designated high risk. More people are transported after such a designation than are on trial at any particular time.

Mr. Kaufman acknowledged that the electronics package has to be in contact with body or with clothing next to the body. It can be slid around the body, and while Stun-Tech recommends a particular placement, it can be positioned anywhere. The optimal placement is near the left kidney area, which he demonstrated to be under the left arm.

Stun-Tech first developed an earlier version of the HSTB and later developed the MSB as a lower cost alternative. Thus, the early literature was only referring to the HSTB when it described the belt as a low profile control in court settings.

Mr. Kaufman declined to state that one belt was more adaptable to courtroom use, and the other to transportation, when offered the chance to make such a distinction. Instead, he said that price is the only difference between belts and that both are marketed to the same customers.

He stated, however, that the R-E-A-C-T belt was never marketed for use under clothing and, once the licensing agreement ended, it was never advertised for use under clothing.

Brian Willoughby, vice president of R.A.C.C., described an out of court demonstration depicted in photographs that are exhibits attached to Plaintiff's Opposition to the Motion for Reconsideration (paper no. 110).[5] He obtained a prototype belt from Stun-Tech that, except for the electronics package, is identical to the belt brought to the hearing. If anything, the current electronics package is more compact than the one he tested. Handcuffs and leg chains were attached to the HSTB, placed around him, and he then tried to hide the entire apparatus by placing the chains and handcuffs in his pockets. There are three photographs, and Mr. Willoughby testified that he is wearing the same equipment in all three. In the first, he is standing with the belt, handcuffs and shackles entirely visible. In the next, he has the hardware in his pockets and a sweater covers the belt. The last shows the same arrangement, but with the sweater lifted up to reveal the belt and a portion of the chains.

Based on all the evidence presented, the court concludes that both belts infringe the '885 patent and must not be produced or sold by Stun-Tech in their present form without a license from Plaintiff. The MSB easily meets all of the claims in the '885 patent. The HSTB, too, is capable of being concealed underneath clothing,

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[5] Some exhibits were not marked again if they were already in the record.

although it is slightly more bulky. The addition of wrist cuffs and metal rings does not significantly alter the dimensions so as to prevent its concealment under clothing. Neither belt can be worn too far from the person's body because the electric shock will not penetrate a very thick layer, or layers, of clothing. While it may be possible to wear the belt over some indoor clothing, it also can be worn underneath. The fact that customers have not used it frequently in courtroom settings, with or without juries present, or that they find it more useful in transport situations, are immaterial to the inquiry. Each belt is capable of being worn concealed, secured to the torso of the prisoner, so as to meet all of the patent claims.

III. Conclusion

For the foregoing reasons, an injunction will issue prohibiting the manufacture and sale or other distribution of both R-E-A-C-T Belts during the remainder of the life of the '885 patent.

/s/ Deborah K. Chasanow
DEBORAH K. CHASANOW
United States District Judge

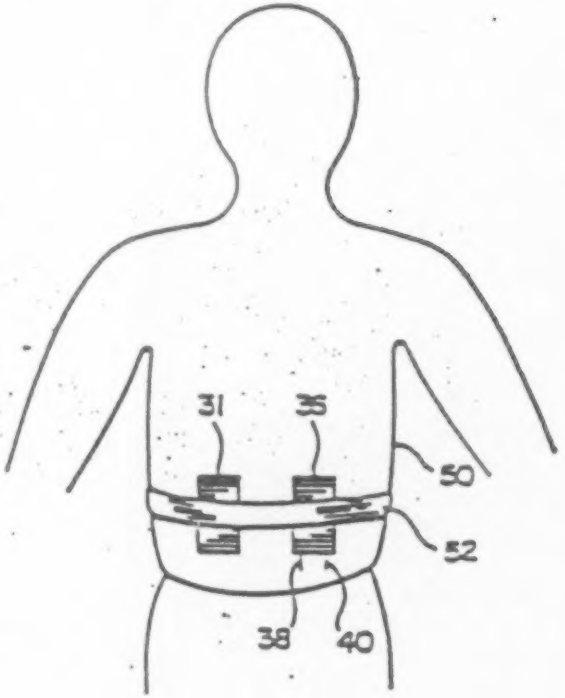
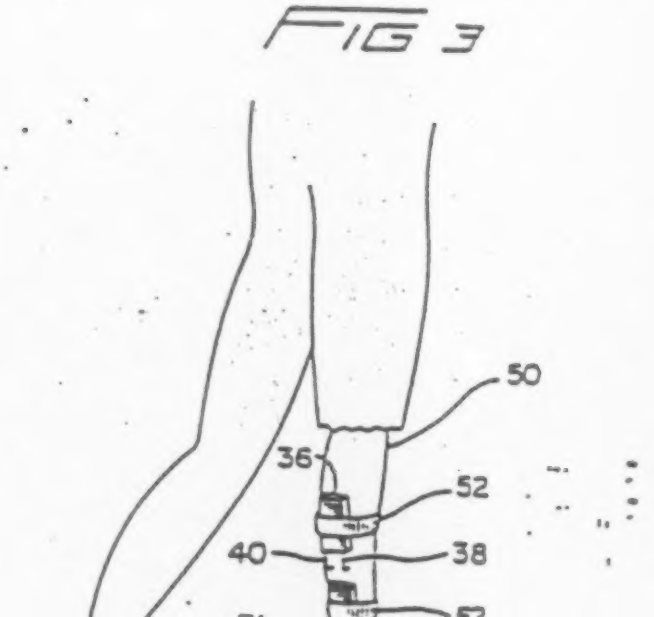


FIG 3



App. 20

FIG 2

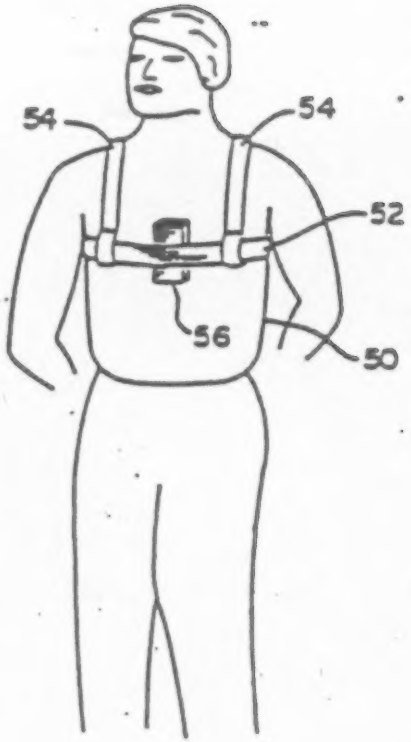


FIG 4

FIG 5

(2)

Supreme Court, U.S.
FILED
APR 21 1999
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No. 98-1393

In The

Supreme Court of the United States

October Term, 1998

STUN-TECH, INC.,

Petitioner,

vs.

R.A.C.C. INDUSTRIES, INC.,

Respondent.

On Petition For Writ Of Certiorari To The United States Court Of Appeals For The Federal Circuit

BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

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RESPONDENT'S BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

COUNTER-STATEMENT OF THE CASE

Respondent generally agrees with the Petitioner's Statement of the Case. It disagrees, however, with the summary of the patent specifications set forth at page 3 of the Petition and refers the Court to the relevant claims of the patent itself, set forth verbatim at pages 4-5 of the Petition. Respondent further would point out that the last two paragraphs of the Statement of the Case, referring to Petitioner's High Security Transport Belt ("HSTB"), is somewhat misleading and inconsistent with the evidence presented to the District Court. While there was testimony from Petitioner's president that the HSTB is used primarily for transport of prisoners and not for in-court situations, there were also documents introduced into evidence which established that the HSTB is in fact used from time to time in court, with the belt concealed underneath a prisoner's clothing. Furthermore, there was an in-court demonstration of the HSTB which conclusively established that the device was capable of being "adapted for concealment beneath garments", as described in Claim 1 of the Patent.

REASONS FOR DENYING THE WRIT

Even if the question presented for review were answered in the affirmative, there would be no basis for reversal of the decision of the United States Circuit Court for the Federal Circuit. That decision was based, as was

that of the District Court, on the structural limitations of the patent claims found to have been infringed.

The Petition points to no error in the decisions below in interpreting the claims of the '885 Patent. It points to no problems experienced by District Courts in interpreting apparatus claims containing functional language. Nor does Petitioner advance any compelling reason why this Court is being called upon to define a new type of claim which has not been provided for by statute.

The Petition does not point to any inequity which would be worked upon the infringer by denial of the Petition. Petitioner has admitted that one of its two models, namely, the Minimum Security Belt ("MSB"), is an infringement of Claims 1 and 4 of the '885 Patent, and it has acknowledged that the other model, the HSTB, is also capable of infringing.

The Petition is founded upon the factually erroneous premise that the claims of the patent in suit are apparatus claims which were allowed by the Patent and Trademark Office only "when the functional language . . . was added to the claims and it was urged that the patented device could be worn under clothing where it would be effectively concealed". Petition, at p. 8. This conclusion is completely contrary to the findings of fact below. As the Federal Circuit noted,

> This prosecution history shows that RACC was unable to distinguish its invention from the prior art based solely on intended use. Only by adding the structural limitation requiring torso

> mounting did RACC successfully overcome the prior art.

App. 8 to the Petition.

The District Court found that the accused MSB and HSTB models were adapted for concealment. The Petitioner did not challenge the findings that its MSB infringed Claims 1 and 4. Petitioner's counsel also conceded at oral argument before the Federal Circuit, as he did in Petitioner's main brief in that Court, that the HSTB is used in courtroom situations wherein it is adapted, as well as intended, to be concealed. The District Court's analysis was rigorous and scrupulously adhered to a structural, element-by-element application of the claims against the infringing belts. Petitioner cannot point to any faulty reasoning in the opinions below.

Petitioner has had its day(s) in court, but now wants this Honorable Court to devise a completely new form of claim which it admits is not provided for by statute. Such a new, hybrid form of claim would not relieve Petitioner from the fact that it has infringed the new and non-obvious structural limitations of the claims in suit, as specifically found by the District Court below. For that reason alone, the Petition should be denied.

Respectfully submitted,

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